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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,593	06/24/2003	Koji Naoe	Q76204	1475
23373	7590	04/27/2006		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER BASHORE, ALAIN L				
ART UNIT			PAPER NUMBER	
1762				

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/601,593

Applicant(s)

NAOE, KOJI

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, with respect to the outstanding office action have been fully considered and are persuasive in view of perfecting the priority date. The finality of previous office action has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the Japanese patent to Sueyoshi et al.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-3, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sueyoshi et al (with translated portion of abstract and constitution provided) in view of Ogawa et al.

Sueyoshi et al discloses a method for producing a magnetic recording medium having a nonmagnetic substrate coated with a magnetic coating material containing a

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ferromagnetic powder and a binder. A ferromagnetic powder and solvent is disclosed as initially separate from a binder (see translated portions provided).

There is not explicitly disclosed (in the translated portions provided) the use of ultrasonic wave being applied after mixing liquid A and solution B.

Ogawa et al discloses ultrasonic mixing (col 15, lines 15-22).

It would have been obvious to one with ordinary skill in the art to include ultrasonic mixing because Ogawa et al teaches functional equivalence to other types of mixing (col 15, lines 15-22).

4. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sueyoshi et al in view of Ogawa et al as applied to claims above, and further in view of Ikeuchi et al.

Sueyoshi et al and Ogawa et al do not disclose needle particle dimensions as claimed in claims 4 and 7.

Ikeuchi et al discloses needle particle dimensions as claimed in claims 4 and 7 (para 0081).

It would have been obvious to one with ordinary skill in the art to include needle particle dimensions as claimed in claims 4 and 7 because Ikeuchi et al teaches advantages of needle particle use (para 0081).

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5. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sueyoshi et al in view of Ogawa et al as applied to claims above, and further in view of Akashi et al

Sueyoshi et al and Ogawa et al do not disclose plate particle dimensions as claimed in claims 5 and 8.

Akashi et al discloses plate particle dimensions as claimed in claims 5 and 8 (col 3, lines 24-40).

It would have been obvious to one with ordinary skill in the art to include plate particle dimensions as claimed in claims 5 and 8 because Akashi teaches advantages for using plate type particles (col 1, lines 15-39).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore  
Primary Examiner  
Art Unit 1762